

Appl. No. # 10/798,683
Amdt. dated 09/02/2005
Reply to OA of 07/01/2005
REMARKS

Buettell 6,684,544 is a magnetic card holder and Clinkscales 5,010,665 is a lighted badge. It may appear to be an elementary task to combine the magnetic card holder to the lighted badge, this is actually not so obvious.

The prior art does not show an illuminated badge structure with a magnetic holding means. MPEP 706.02(j) (D) suggests that an obviousness rejection require "(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification." The badge structure of Clinkscales does not necessarily damage the user's clothing, and adding the magnetic holding method had been known in the era that the Clinkscales reference was written. Therefore, the applicant suggests that a long felt need, and failure of others to create or describe the device would make the invention not obvious.

MPEP 706.02(j) To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

There is no express teaching or suggestion to make the combination.